

REMARKS

In the last office action, the examiner found the previous arguments to be persuasive and therefore withdrew the rejection. He also found that the amendment overcame the objection. The examiner then issued a new rejection under 35 USC 103 based upon the combination of a previously applied reference and a newly applied reference: R Dzwonczyk et al "Myocardial Electrical Impedance Responds to Ischemia and Reperfusion in Humans," *Computers in Cardiology*.

However, the newly applied reference is NOT prior art against this application for the reasons explained below. Therefore, the case is believed now in condition for allowance of claims 1 and 2, which is respectfully requested.

The applicable sections of the M.P.E.P are MPEP 715.01(c), the first paragraph and the subsequent section I, and MPEP 716.10. Applicant submits herewith a declaration of an inventor and author showing two things. First, the declaration shows the publication date of the reference so that it can be seen that the reference is not a statutory bar because it was published less than one year before applicants' priority filing date. Second, the affidavit shows, as required by section I of MPEP 715.01(c), that the reference article is describing applicants' own work and that those authors of the article who are not inventors, were working under the direction of the inventors. The declaration is filed under 37 CFR 1.132 in accordance with MPEP 715.01(c), section I.

Applicants' effective and priority filing date is May 28, 2003, the date applicants' provisional application was filed. Applicants then filed an International Application claiming priority from the provisional application and designating the U.S. The applicants then entered the national phase in the U.S. and that is the present application

now before the examiner. Consequently, applicants' effective filing date was not very apparent.


The newly cited reference was published on September 22, 2002. That is because the proceedings for the meeting were first distributed at the beginning of the meeting. A copy of a portion of the distributed proceedings is submitted with the declaration. That publication date is also shown by the declaration.

The newly cited reference was a publication by the applicants themselves. As can be seen on the article, there are six named authors. There are four coinventors on this patent application. Three of the coinventors are also listed as authors of the reference. The other three authors, Drs Brown, Michler and Wolf, are the cardiothoracic surgeons who performed the revascularization surgery. They are coauthors on the publication because they gave the inventors the opportunity to measure MEI on their patients in the operating room and helped accomplish that. Including them as coauthors is an appropriate thing to do in the scientific community. They are not, however, coinventors on this patent application and did not contribute to the teachings or invention of this patent application. Consequently, with respect to the invention and the data that is the subject of this patent application, the surgeons were merely working under the direction of the inventors.

Therefore, the reference should be withdrawn and claims 1 and 2 should now be allowed.

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,



19 December 2008
Date of Signature

Frank H. Foster,
Reg. No. 24,560
KREMBLAS, FOSTER, PHILLIPS & POLLICK
7632 Slate Ridge Blvd.
Reynoldsburg, OH 43068
Voice: 614/575-2100
Fax: 614/575-2149
email: ffoster@ohiopatent.com

I:\client.docs\o\ohio state university - osu\gen 2949 heart viability dzwonczyk\us\docs for response to oa of 9-19-08\response to oa of 9-19-08.doc